

REMARKS

Reconsideration and withdrawal of the rejections of the claimed invention is respectfully requested in view of the amendments, remarks and enclosures herewith, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-4, 7 and 8 are pending in this application. New claims have been added and are intended to correlate to the examples in the specification as follows:

Claim 9 is a narrower embodiment of claim 1;

Claim 10 encompasses the examples of Table 1, wherein $n = 1$, $p = 1$ and $m = 0$;

Claim 11 encompasses the examples of Table 1, wherein $n = 1$; $p = 1$ and $m = 1$;

Claim 12 encompasses the examples of Tables 2 and 10, wherein $n = 1$, $p = 0$ and $m = 1$;

Claim 13 encompasses the examples of Table 2, wherein $n = 1$, $p = 0$ and $m = 0$;

Claim 14 encompasses the examples of Tables 2, 3, 9 and 10, wherein $n = 0$, $p = 0$ and $m = 1$;

Claim 15 encompasses the examples of Table 2, wherein $n = 0$, $p = 0$ and $m = 0$;

Claim 16 encompasses the examples of Table 4, wherein R_2 and R_4 is $C=O$;

Claim 17 encompasses the examples of Table 5, wherein $n = 1$, $p = 1$, $m = 0$ and R_2 and R_3 together is a bond;

Claim 18 encompasses the examples of Table 5, wherein $n = 1$, $p = 1$, $m = 1$ and R_2 and R_3 together is a bond;

Claim 19 encompasses examples 2.1-2.4;

Claim 20 encompasses examples 5.1 and 5.2.

No new matter has been added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE 35 U.S.C. 112, 1st PARAGRAPH REJECTION HAS BEEN OVERCOME

Claims 1-4, 7 and 8 were rejected as allegedly lacking adequate written description. The applicants request reconsideration of this rejection as there was no explanation for the basis for this rejection beyond simply recited a passage from MPEP 2163.06.

As noted in MPEP 2163, section I.A:

There is a **strong presumption that an adequate written description** of the claimed invention **is present** when the application is filed. *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) ("we are of the opinion that the **PTO has the initial burden of presenting evidence or reasons** why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.")

Also, as noted in MPEP 2163, section II:

While a question as to whether a specification provides an adequate written description may arise in the context of an original claim which is not described sufficiently (See *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 43 USPQ2d 1398 (Fed. Cir. 1997)), there is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed. *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). **Consequently, rejection of an original claim for lack of written description should be rare.** (emphasis added)

The strength of this presumption is such that in order to satisfy the description requirement of section 112, first paragraph, an application merely needs to disclose a statement of the applicant's invention [in his specification] which is as broad as appellant's broadest claim. See *In re Eickmeyer*, 202 USPQ 655, 662 (CCPA 1979).

In addition, while specific examples are not necessarily required to show possession of the invention, the applicants not only provided at least six examples which were tested for their efficacy as pest controlling agent, but also exemplified over 450 different compounds in the Tables within their specification. There was no explanation as to why one of ordinary skill in the art would have viewed the applicants as lacking possession of the invention given this degree of additional description provided above and beyond the scope of the invention represented by the originally filed claims (which were also supported in the specification).

Given the level of description present within the applicants' specification and the fact that the claims rejected were the applicants originally filed claims, the Office Action has not overcome the strong presumption that the applicants have provided an adequate written description of the invention. Therefore, this rejection should be withdrawn.

III. THE 35 U.S.C. 103(a) REJECTION HAS BEEN OVERCOME

Claims 1-4, 7 and 8 were rejected as allegedly being obvious by LINN et al. (EP 343 708 - U.S. Patent 4,873,224 is the parallel U.S. application - "Linn"). The applicants request reconsideration of this rejection for the following reasons.

Contrary to the assertion in the office action, the instant claims do not differ from Linn in that "they are of different generic scope". They are different sets of compounds entirely.

Particular attention is directed toward the glycosyl moiety at the C-13 position of the avermectin. The moieties of Linn at R¹ are not the same as those in the corresponding position of the applicants' avermectin compounds as claimed in the present invention (see chart below):

Compounds of Linn	Applicants claimed compounds

The difference becomes even more pronounced when the variables n and/or p are 1. As all of the claimed limitations have not been taught or suggested by Linn, there can be no holding of *prima facie* obviousness and this rejection should be withdrawn.

Claims 1-4, 7 and 8 were rejected as allegedly being obvious by OMURA et al. (U.S. Patent 6,605,595 - "Omura:). The applicants request reconsideration of this rejection for the following reasons.

Contrary to the assertion in the office action, the instant claims do not differ from Omura in that "they are of different generic scope". They are different sets of compounds entirely. A broad reading of the compounds of U.S. Patent 6,605,595 would encompass the structure and definitions referred to in the "Disclosure of the Invention" (see col. 1, line 34 through col. 2, line

58). The compounds referred to wherein the variable R¹ forms a **double bond** with the saccharide **are not** within the scope of the presently claimed avermectin derivative compounds, i.e. 1), 2), 3) and 4) - see col. 1, lines 61-62, col. 2, lines 24-25, col. 2, lines 35-36 and col. 2, lines 47-48, respectively.

With regard to the avermectin derivative compounds of R¹ for 3) where there is a single bond linking R¹ to the saccharide moiety - see col. 2, lines 39-42 - the Omura compounds define R¹ to be a carboxymethyl group (-CH₂COOH) or a cyanomethyl group (-CH₂CN). The claims as originally presented **did not encompass** these moieties which were referred to in Omura.

As all of the claimed limitations have not been taught or suggested by Omura, there can be no holding of *prima facie* obviousness and this rejection should be withdrawn.

CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By: Howard C. Lee
Thomas J. Kowalski Howard C. Lee
Reg. No. 32,147 Reg. No. 48,104
Telephone: (212) 588-0800
Facsimile: (212) 588-0500